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Paper 4

FACTOR AND PARTNERS, L.L.C.
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SUITE 300
CHICAGO, IL 60603

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JAN 22 2002

OFFICE OF PETITIONS

In re Application of
Joshi
Application No. 09/649,563
Filed: 28 August, 2000
Attorney Docket No.: 98125CP01

ON PETITION

This is a decision on the pleading filed on 15 October, 2001, presented: "[a]ccordingly, under 37 C.F.R. Sec. 1.81 (sic), please consider the below remarks toward withdraw (sic) of the abandonment of the present application . . ." and properly considered as a request, under 37 C.F.R. §1.181¹ for the withdrawal of the holding of abandonment.

The petition is **DISMISSED**.²

NOTES:

(1) Any request for reconsideration of this decision under 37 C.F.R. §1.181 must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted.

However, Petitioner is reminded that extensions of time are not recoverable as patent term extensions or adjustments.

The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

(2) Alternatively, as indicated, *infra*, petitioner may file a petition under 37 C.F.R.

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. ***

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. ***

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. ***

² As discussed, *infra*, Office records indicate that Petitioner failed to pay the petition fee when the decision on the first petition was rendered in August, 1999; further, as of this writing Petitioner has not been charged for this second petition. Pursuant to Petitioner's authorization, the two petition fees, each of \$130.00, for a total of \$260.00, are charged to Deposit Account 50-0965.

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OFFICE OF PETITIONS

§1.137, ¶(b)³ for revival of an application abandoned due to unintentional delay in responding to an Office action.

(3) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

A review of the record reveals that:

- the instant application was filed on 28 August, 2000;
- on 17 October, 2000, the Office mailed a Notice of Missing Parts, requiring that a statutory fee, funds for additional claims and a properly signed oath or declaration and the late-filing surcharge be filed within two months (i.e., on or before 17 December, 2000);
- Petitioner did not respond timely to the Notice of Missing Parts, and the application went abandoned after midnight 17 December, 2000;
- no Notice of Abandonment was mailed;
- on 15 October, 2001, Petitioner filed the instant application with:
--copies of letters of June 8 and September 13, 2001, inquiring about matters in six applications, of which the instant application is one,

³ The regulations at 37 C.F.R. §1.137 provide in pertinent part:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application or lapsed patent;

(2) The provisions of § 1.550(c) for a terminated *ex parte* reexamination proceeding filed under §1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination proceeding filed under §1.913.

[47 Fed. Reg. 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 Fed. Reg. 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 Fed. Reg. 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (c) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000]

- a copy of the date-stamped receipt card evidencing the filing of the instant application;
- a copy of the Notice of Missing Parts (which Petitioner acknowledges was received by him via FAX on 27 September, 2001), and
- a petition fee of \$130.00, which the Office "booked" as the late-filing surcharge.

(However, while Petitioner has acknowledged receipt of the Notice, as of this writing Petitioner has not submitted the basic filing fee⁴ or filed the signed oath or declaration.)

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁵ And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably⁶ or unintentionally, respectively, abandoned application under this congressional grant of authority. Further, Petitioner must evidence at least such diligence in addressing a question of abandonment as one must evidence in the prosecution of the application--i.e., such diligence as one would give to one's most important business affairs.⁷

Moreover, the courts have determined the construct for properly supporting an allegation of non-receipt of an Office action in seeking withdrawal of a holding of abandonment.⁸

⁴ As noted at the end of page 3, above, the \$130.00 submitted by Petitioner as a petition fee has been credited by the Office as the late-filing surcharge (also \$130.00).

⁵ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁶ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional. Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887). See also: In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). Decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of proof. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁸ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Petitioner's Allegation of Non-Receipt

Save for Petitioner's statement, Petitioner's allegation of non-receipt of the Notice of Missing Parts is unsupported—there is no documentation evidencing non-receipt. There are no copies of the mail-receipt log(s); no description of Petitioner's procedures for collecting and reviewing in-coming mail and or statement from any staff support personnel in Petitioner's who handle those responsibilities:

(1) the method used for recording/tracking incoming and outgoing communications regarding applications in general and this application in particular, and

(2) the manner in which this application was in fact handled by the applicant and/or those acting on behalf of the applicant.

Petitioner stated in a telephone conversation of 8 January, 2002, that he maintains no logs of incoming and/or outgoing mail. While:

- Petitioner's staff indicated in a telephone conversation of 8 January, 2000, that Petitioner's offices were relocated by January, 2001,⁹ and
- the record contains no indication that Petitioner ever filed or record a Notice of Change of Address,

Office records suggest that Petitioner may have used his Customer Number to give this notice. However, the record is silent as to when the move occurred and when the change of address occurred.

Given that:

- Petitioner has presented no documentary evidence in support of the allegation of non-receipt, and
- the record is silent as to when Petitioner moved and acted to advise the Office as to the change of address,

as of this writing, Petitioner's showing clearly is insufficient to support of record his contention that the October Notice was not received.

Thus it is not possible for the Office to conclude that Petitioner has carried his Delgar v. Schulyer burdens.

Withdrawal of the holding of abandonment is not proper.

⁹ An employee of the Petitioner's office indicates that Petitioner's offices were relocated from West Monroe Street, Chicago, IL, to West Washington Boulevard, Chicago, IL, by January 2001.

ALTERNATIVE VENUE

As set forth above, it appears at this writing that Petitioner's only alternative to irretrievable abandonment is to:

- file a petition and fee as set forth at the NOTE 2, page 2, under 37 C.F.R. §1.137(b), and
- state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

Petitioner's failure to seek timely such relief may be considered intentional delay, which would be a permanent bar to revival.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
 2201 South Clark Place
 Arlington, VA 22202

Telephone inquiries should be directed to John J. Gillon, Jr., Attorney, Office of Petitions, at (703) 305-9199.


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